

REMARKS

This Amendment is submitted in response to the Office Action dated December 20, 2005. In the Office Action, the Patent Office objected to Claim 19 due to an informality. Further, the Patent Office rejected Claims 1-6, 8-16, 18 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fano* (U.S. Patent Application No. 2005/0091118) in view of *Erickson* (U.S. Patent No. 6,014,644). Still further, the Patent Office rejected Claims 7 and 17 under 35 U.S.C. §103(a) as being unpatentable over *Fano* in view of *Erickson* as applied to Claims 1-6, 8-16, 18 and 19 and further in view of *Ling* (U.S. Patent Application No. 2002/0002538). Moreover, the Patent Office rejected Claim 20 under 35 U.S.C. §103(a) as being unpatentable over *Fano* in view of *Erickson* as applied to Claims 1-6, 8-16, 18 and 19 and further in view of *Schuller et al.* (U.S. Patent Application No. 2001/0047250).

By the present Amendment, Applicant amended Claims 1, 6, 8 15 and 19. Applicant submits that the amendments to the claims overcome the rejections by the Patent Office and place the application in condition for allowance. Notice to that effect is respectfully requested.

With respect to the objection of Claim 19, the Patent Office alleges:

Claim 19 is objected to because of the following informalities: Claim 19 reads 'information base on the user information' and should read 'information based on the user information.'

Claim 19 in accordance with the suggestion of the Patent Office.

With respect to the rejection of Claims 1-6, 8-16, 18 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fano* in view of *Erickson*, the Patent Office alleges:

Regarding Claim 8, *Fano* teaches: providing a computer network (see at least: [038]; [0176]; FIG. 10A); providing a database connected to the computer network wherein the database includes merchant information associated with the merchant and further wherein the merchant information includes the location of the merchant within the multi-dealer retail establishment (see at least: [0009]; [0028]; FIG. 27). The Examiner notes that the PDA device works in conjunction with the GPS system to display the physical location of the user on a map of the mall (*multi-dealer retailer establishment*) the user is currently in. The map further displays merchant location and destination information. It is thereby inherent that a database exist containing map and location information for the merchants in the mall in order to display such information on the display of the PDA or other similar device; inputting a product list of the merchant into the merchant information in the database wherein the product list includes item information associated [stat] the item offered for sale by the merchant (see at least: [0178]). [stat] providing a display [stat] a first access to the database for viewing the merchant information of the merchant in the database via the computer network (see at least: [0282]; [0288]; FIG. 27); searching the product list in the merchant information based on the item information associated with the item (see at least: [0284]; [0288]; FIG. 27). The Examiner notes that the search is automatically done by the system in order to display products of interest to the user based on product information input by the user that matches the information in the product information in the database; determining the location of the merchant in the multi-dealer retail establishment based on the merchant information associated with the item information in the product list (see at least: [0288]; FIG. 27).

Fano, however, does not show a single database containing both location information and product information for a merchant. *Erickson* teaches a system and method for facilitating communication between multiple buyers and suppliers in which a database

contains information on a number of buyers and suppliers (see at least: abstract). *Erickson* differs from *Fano* in that *Erickson* provides a single database for storing merchant information as opposed to two or more databases (see at least: col. 3, lines 31-42).

In response to the rejections under 35 U.S.C. §103(a), Applicant amended Claims 1, 6, 8, 15 and 19. Applicant asserts that the amendments overcome the rejection under 35 U.S.C. §103(a). Notice to that effect is requested.

Claim 1, as amended, requires a computer terminal located in the multi-dealer retail establishment wherein the computer terminal connects to the computer network and enables access to the item information and the merchant information. Further, Claim 1 requires that the computer terminal is remote with respect to the database and determines the location of the item in the multi-retailer establishment by searching item information in the database.

Claim 8 requires that the terminal is only accessible at the multi-dealer retail establishment. In addition, Claim 8 requires that the terminal displays the location of the item in the multi-retail establishment based on the merchant information.

Fano merely teaches a system having a personal digital assistant ("PDA") and a global positioning system ("GPS") for determining the availability of products in a mall. The PDA device works in conjunction with the GPS to display the physical location of the user on a map of the mall. In addition, the PDA provides access to a database 1050 which stores product lists,

features and descriptions.

Erickson merely teaches a system where buyers request bids from multiple sellers. In response, the sellers send pricing information to the buyer. Furthermore, *Erickson* merely teaches a service provider that collects product information from the seller and stores the information in a database.

Neither *Fano* nor *Erickson*, taken singly or in combination, teaches or suggests a computer terminal located in the multi-dealer retail establishment wherein the computer terminal connects to the computer network and enables access to the item information and the merchant information, as required by Claim 1. Further, neither *Fano* nor *Erickson*, taken singly or in combination, teaches or suggests that the computer terminal is remote with respect to the database and determines the location of the item in the multi-retailer establishment by searching item information in the database, as required by Claim 1. *Fano* merely teaches a PDA which accesses product lists, features and descriptions. *Fano* teaches away from the present invention as defined by Claim 1. Specifically, *Fano* requires accessing multiple databases to identify and to locate items offered by merchants in a multi-retail establishment. Likewise, *Erickson* teaches away from the present invention as defined by Claim 1. Specifically, *Erickson* teaches that a buyer communicates with each of the sellers in order to obtain product information. Therefore, neither *Fano* nor *Erickson*, taken singly or in

combination, teaches or suggests the present invention as defined by Claim 1.

Neither *Fano* nor *Erickson*, taken singly or in combination, teaches or suggests that the terminal is only accessible at the multi-dealer retail establishment, as required by Claim 8. *Fano* actually teaches away from the present invention as defined by Claim 8. Specifically, *Fano* teaches using a portable PDA which is accessed at locations remote from the multi-dealer retail establishment, such as, for example, at a home of a user prior to arriving at a shopping mall. *Erickson* merely teaches storing supplier information in a central database 24. Therefore, neither *Fano* nor *Erickson*, taken singly or in combination, teaches or suggests that the terminal is only accessible at the multi-dealer retail establishment, as required by Claim 8.

Furthermore, neither *Fano* nor *Erickson*, taken singly or in combination, teaches or suggests that the terminal displays the location of the item in the multi-retail establishment based on the merchant information, as required by Claim 8. *Fano* teaches locating a merchant using a global positioning system stored on a first database remote with respect to a second database storing the merchant information. *Erickson* merely teaches a buyer requesting a bid from multiple suppliers. Therefore, neither *Fano* nor *Erickson*, taken singly or in combination, teaches or suggests that the terminal displays the location of the item in the multi-retail establishment based on the merchant information,

as required by Claim 8.

With respect to the rejection of Claims 7 and 17 under 35 U.S.C. §103(a) as being unpatentable over *Fano* in view of *Erickson* as applied to Claims 1-6, 8-16, 18 and 19 and further in view of *Ling*, Applicant submits that the rejection under 35 U.S.C. §103(a) has been overcome in view of the foregoing amendments and the remarks that follow.

In the Office Action, the Patent Office alleges:

Fano and *Erickson* teach all of the above as noted and further teach entering product information into the database (see at least: *Fano*, [0179]; [0202]). *Fano* and *Erickson*, however, do not teach downloading an image into the item information of the item in the database via the computer network wherein the image is associated with the product. *Ling* teaches a system and method for electronic purchases. *Ling* additionally teaches a product database containing product information including product images, descriptions, stock available, etc. (see at least: [076]).

Claims 7 and 17 depend from independent Claims 1 and 8, respectively. *Ling* fails to teach or to suggest the elements of the present invention which are not taught by *Fano* and *Erickson*, as required by amended independent Claims 1 and 8. Accordingly, the rejections of Claims 7 and 17 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Moreover, a person of ordinary skill in the art at the time of Applicant's invention would never have been motivated to combine *Fano*, *Erickson* and *Ling* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C.

§103(a). More specifically, Applicant submits that the Patent Office is merely "piece-mealing" references together, providing various teachings and positively defined limitations of Applicant's system and method for locating an item to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is impermissible. Accordingly, Applicant respectfully submits that Claims 7 and 17, distinctly define the present invention from *Fano*, *Erickson* and *Ling*, taken singly or in combination.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to

make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Fano*, *Erickson* and *Ling* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Fano* and *Erickson* with *Ling* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

With respect to the rejection of Claim 20 under 35 U.S.C. §103(a) as being unpatentable over *Fano* in view of *Erickson* as applied to Claims 1-6, 8-16, 18 and 19 and further in view of *Schuller et al.*, Applicant submits that the rejection under 35 U.S.C. §103(a) has been overcome in view of the foregoing amendments and the remarks that follow.

In the Office Action, the Patent Office alleges:

Regarding Claim 20, *Fano* and *Erickson* teach all of the above as noted and further teach entering merchant information including product offerings into a database (see at least: *Fano*, [0178]). Additionally, the system of *Fano* informs users of the availability of items of interest in surrounding stores (see at least: *Fano*, abstract; [0286]). *Fano* and *Erickson*, do not teach inputting inventory of the merchant into the database via the computer system wherein the inventory is associated with the product list of the merchant and further wherein the inventors includes the item for sale and modifying the inventory of the merchant via the computer system. *Schuller* [stat] teaches a system for viewing and purchasing structural and decorative materials. The system includes a database containing vendor information such as product prices, stock

availability (i.e. inputted inventory of the vendo), location, etc. The system also provides for updated (i.e. modified) inventory information (see at least: abstract; [049]).

Claim 20 depends from independent Claim 8. *Schuller et al.* fails to teach or to suggest the elements of the present invention which are not taught by *Fano* and *Erickson*, as required by amended independent Claim 8. Accordingly, the rejections of Claim 20 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Moreover, a person of ordinary skill in the art at the time of Applicant's invention would never have been motivated to combine *Fano*, *Erickson* and *Schuller et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). More specifically, Applicant submits that the Patent Office is merely "piece-mealing" references together, providing various teachings and positively defined limitations of Applicant's system and method for locating an item to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is impermissible. Accordingly, Applicant respectfully submits that Claim 20, distinctly defines the present invention from *Fano*, *Erickson* and *Schuller et al.*, taken singly or in combination.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Fano*, *Erickson* and *Schuller et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Fano* and *Erickson* with *Schuller et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Claims 2-7 depend from Claim 1; Claims 9-20 depend from Claim 8. These claims are further believed allowable over the references of record for the same reasons set forth above with

respect to independent Claims 1 and 8 since each sets forth additional novel elements and steps of Applicant's system and method, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

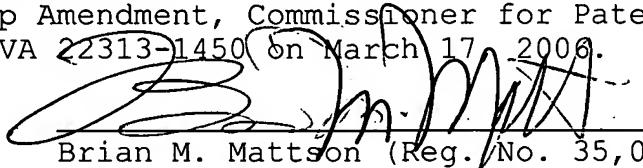
Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this **Amendment and Transmittal (in duplicate) and return postcard** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 17, 2006.



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